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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,695	03/22/2004	Paul V. Greco	GRECO-001	8733
36822 7590 01/09/2008 GORDON & JACOBSON, P.C. 60 LONG RIDGE ROAD SUITE 407 STAMFORD, CT 06902			EXAMINER LEFF, STEVEN N	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/805,695	GRECO ET AL.	
	Examiner	Art Unit	
	Steven Leff	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, and 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claims 1-5, 10-13, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arcari (GB 2247001) in view of Kasket (3257212) and further in view of Kim (6221309) as evidenced by www.mightybeancoffee.com ("Tea Rock" teabag weight, March 2004).

With respect to claims 1-5, 10-13, and 18-19, Arcari teaches a body portion comprising overlying layers of porous material (pg. 4 line 10+) that are joined to form at least one compartment (pg. 4 line 15+), said at least one compartment carrying infusion beverage product (pg. 4 line 5), such as coffee, tea, or milk powder (pg. 4 line 11+), in addition to a weight that causes said body portion to sink in water (pg. 4 line 6). Arcari further teaches that the at least one compartment carries an agent that imparts flavor into a solution during steeping (pg. 4 line 6+), that the layers of porous material are joined together by stitching to form the at least one compartment, and that the at least one compartments comprises a first compartment distinct from a second compartment, where the first compartment carries an infusion beverage and the second compartment carrying the weight.

Arcari further teaches that the weight comprises a dissolvable agent, where the dissolvable agent comprises a sweetener, such as sugar (pg. 4 line 7+). In addition, the porous material comprises a sheet of fibrous cellulosic material which withstands immersion into boiling water without damage, as well as being non-toxic, odorless, and flavorless. Regarding claim 10, Arcari teaches that the envelope is made of “perforated paper” (pg. 4 line 10+) where paper is made from cellulose.

With respect to claim 11, Arcari teaches that the pouch (7) is “placed into a container of hot or boiling water” (pg. 4 line 19+). Therefore, since the package of Arcari is intended to be used in an environment, which includes boiling water without degrading the package, Arcari would be expected to meet the limitations of claim 11. Arcari continues by teaching that the beverage package includes a string anchored to the body portion at one end of the string and a tag at the other end of the string (pg. 4 line 17).

However Arcari is silent with respect to the use of a weight which is from the group consisting of ceramic material, porcelain material, and naturally occurring rock material.

With respect to claims 1-5, 10-13, and 18-19, Kasket (3257212) teaches a non-floating beverage package, which will remain fully immersed in the infusion liquid and resist any tendency to float (col. 1 line 31+). Kasket continues by teaching a body portion, which comprises overlying layers of porous material (col. 2 line 5+) that are joined to form at least one compartment (col. 1 line 61+), said at least one compartment carrying infusion beverage product (col. 1 line 10+), in addition to a weight that causes said body portion to sink in water. It is noted that in this instance the weight is taken to be the weight described on lines 37+ of column 2, where the weight is a non-toxic, water-insoluble substance (col. 2 line 38), however Kasket does not specifically recite that the weight may be within the same porous body portion as the infusion beverage product.

However with respect to claims 1-5, 10-13, and 18-19, it would have been obvious to one of ordinary skill in the art to incorporate the weight, which Kasket discloses, into the invention of Arcari, since Arcari already teaches a weight within a porous compartment (pg. 4 line 6) and since Kasket teaches using a non-toxic, insoluble material as a weight (col. 2 lines 38-40). It would have further been obvious due to the

fact that is noted that “a weight” further increases the rate at which all of the gases are forced to exit the infusible substance when immersed in the liquid, and thereby increases the density of the infusible substance as compared to water. Due to this increased weight and density, the package is forced to sink to the bottom of the container in a timelier manner, as opposed to “a weight” which requires the release of gases itself prior to acting as a weight as is taught by Kasket (col. 1 lines 23-30). Subsequently the package is unable to float and therefore further avoids the need for steeping (col. 1 lines 31-36).

Further it would have been obvious due to the fact that providing the non-toxic, and insoluble material directly within the compartment which houses the infusion product, would allow for an overall reduction in the amount of material required due to the fact that only a single body portion is needed to house both the substance and a weight since the weight is non-toxic, and therefore would not harm the consumer and thus subsequently decrease the overall cost of the product since the amount of needed material is reduced. In addition, by providing the weight within the same body, the package becomes a one-time use package and thus increases the number of overall sales since the weight may not be re-used.

Further, although both Arcari, and Kasket are silent to the use of a weight material which can be heated by microwave radiation in a microwave oven without significant degradation, both Arcari and Kasket teach “a weight”, where Kasket further teaches a non-toxic, naturally occurring weight material (col. 2 lines 38-40), though Kasket is silent to the use of ceramic as the specific weight material. However Kim does specifically teach a ceramic weight material for its art recognized and applicant’s intended function of, not only causing the body to sink in a liquid, but further in order to provide a weight, which is, non-toxic, insoluble, odorless, flavorless and will not degrade (col. 2 line 48-56). Therefore it would have been obvious to one of ordinary skill in the art to substitute the weight material of Kasket, with the weight material as taught by Kim, due to the fact that both are insoluble, non-toxic and flavorless materials, Kim has treated the weight material with extreme heat thereby producing a pure ceramic and thus Kim has increased the number of different application to which the ceramic material may be applied, including as a microwave safe material, as ceramic is well known in the art as a microwave safe material which is used as a weight for helping a tea bag sink, as is further evidenced by the “Tea Rock” teabag ceramic weight described by

www.mightybeancoffee.com (March 2004). Therefore Kim is relied upon for the express purpose of replacing the metal weight of Kasket, where Kasket teaches a non-toxic metal weight and where Kim further teaches a microwave safe, non-toxic material.

In addition, although Kim is silent to the fact that the material will not significantly degrade when exposed to microwave radiation, it is noted that Kim teaches the specific material, i.e. ceramic, as is recited by claim 1 and further teaches the material is being treated for its art recognized and applicant's intended function of preventing significant degradation to the weight material when exposed to different extreme conditions while infusing a beverage, as is further evidence by the "Tea Rock" teabag ceramic weight described by www.mightybeancoffee.com (March 2004) and thus it would be expected to meet the limitations of claim 1, where Kim is relied upon for the express purpose of replacing the metal weight of Kasket, which may be toxic under extreme conditions.

- Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Arcari (GB 2247001) in view of Kasket (3257212) in further view of Kim (6221309) as evidenced by www.mightybeancoffee.com ("Tea Rock" teabag weight, March 2004) and in view of Luckhaupt (2193974).

Arcari, Kasket and Kim are taken as above, however all are silent with respect to the tag carrying product indicia.

With respect to claim 14 Luckhaupt teaches "an improved package for packaging and utilization of infusing material such as tea, coffee, and the like." (pg. 1 col. 1 line 2+). More specifically Luckhaupt teaches, at figure 10, that the tag may carry product indicia.

Therefore with respect to claim 14 it would have been obvious to one of ordinary skill in the art to provide the product indicia on the string tag of Luckhaupt into the string tag of Arcari since both are directed to infusible packages, and a string and tag attached to the infusible package in order to remove the infusible package from the liquid, and further since the product indicia would allow the consumer to identify the product. It is further noted that MPEP 2144.04 (I) states "that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art".

- Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arcari (GB 2247001) in view of Kasket (3257212) in further view of Kim (6221309) as evidenced by www.mightybeancoffee.com ("Tea Rock" teabag weight, March 2004) and in view of Rambold. (3542561)

Arcari, Kasket and Kim are taken as above, however all are silent with respect to the two body portions that extend from a hinged interface.

With respect to claims 15-17 Rambold teaches an "infusion bag containing an infusible substance such as tea, coffee or the like for preparing a beverage." (pg. 1 col. 1 line 21+) More specifically Rambold teaches "an infusion bag comprising at least three chambers all containing infusible substance with two outer chambers connected by a closure. At least one of the chambers has a transverse bend so as to allow the bag to be packaged in a flat condition. During use the bag is in a generally polygonal ring-like form with the lateral chambers spread apart." (abstract)

With respect to claims 15-17, although Arcari teaches a compartmentalized infusion beverage package, which includes a first compartment that includes a weight in the bottom part thereof and a second compartment, spaced from the first, containing an infusion beverage product, Arcari is silent to the fact that a hinge separates two body portions. Rambold does teach a bottom wall which folds for packaging and separates two body portions. Therefore, although Arcari does not teach two body portions that extend from a hinged interface, or a bottom wall which may be folded for packaging, one of ordinary skill would have been motivated to combine the teachings of Kasket and Rambold in order to produce an infusion beverage package which is capable of being more easily and compactly packed for distribution thus decreasing the overall size of the package and increasing the number of packages in a given area due to the body portions by being folded together into a relatively flat condition as Rambold teaches (abstract).

Regarding claim 16, although Arcari teaches a compartmentalized infusion beverage package which includes a first compartment that includes a weight in the bottom part thereof and a second compartment, spaced from the first, containing an infusion beverage product, Arcari is silent to the fact that two body portion are separated

by a hinge, however Arcari does teach that the overall package contains a third bottom compartment containing a weight. Where Rambold does teach two body portions that extend from a hinged interface and further teaches a third “bottom” compartment. In addition, both references teach infusion beverage packages, which would allow for preparation of a beverage, Rambold teaches providing a space that would allow the liquid to flow between the compartments due to the separation of the bodies, where providing more than one chamber would cause the infusion substance to be spread out over a number of chambers and consequently over a larger surface area, thus producing a thinner layer of the substance. A thinner layer of the substance will consequently allow the infusion substance to be more effectively extracted by the infusing liquid. The weight in the bottom wall would increase the overall weight of the package thus preventing floating and causing the package to be completely submerged in the infusing liquid. Therefore, one of ordinary skill would have been motivated to combine the teachings of Arcari and Rambold in order to produce a hinged area between two separate bodies where the two bodies are further separated by a third body forming a bottom wall and containing a weight in order to cause the package to be more conducive to attaining the most advantageous rate of flow through the package and through the infusing substance thus allowing the same concentration of the beverage to be attained in a shorter amount of time as is taught by Rambold (col. 2 line 45+).

Therefore with respect to claims 15-17, it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have produced a beverage infusion package, which includes a weight and further where the package could be folded for packaging and increasing the effectiveness of the package.

Response to Arguments

Regarding applicant’s arguments that: *“There is no reason to believe that a person skilled in the art of manufacturing or designing teabag products would find it obvious to combine a reference that teaches specific steps for molding a specific kind of fishing weight with references relating to the creation or design of teabags or beverage package designs. The Examiner has not shown any teaching, suggestion, or motivation for combining these two references in vastly different fields.”* It is noted that the previous rejection clearly recited the

incorporation of "Tea Rock" teabag ceramic weight described by www.mightybeancoffee.com (March 2004) to prove the point of obviousness and thus applicant has provided no evidence or convincing arguments to support their position, in light of "Tea Rock" teabag ceramic weight described by www.mightybeancoffee.com (March 2004), other than to simply disagree with the position of the Office. However the last Office action set forth clear reasons why the instant claims are rejected over the prior art.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the previous rejection clearly taught the obviousness of introducing a ceramic weight into an infusion package.

In response to applicant's argument that the weight of Kasket and Kim and Arcari is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the previous rejection clearly taught the obviousness of introducing a ceramic weight into an infusion package using in light of the teaching of the prior art.

With regard to applicant's argument with regard to claim 2 on page 9, applicant is urged to page 4 line 7 of Arcari which teaches that the weight comprises a dissolvable agent, where the dissolvable agent comprises a sweetener, such as sugar.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The previous Office action clearly established a prima facie case of obviousness in light of the teaching of the prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SL

5/4/08
1/7/08


DREW BECKER
PRIMARY EXAMINER
1/7/08